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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,128	02/08/2002	Shutsung Liao	10634-005001	2665

26161 7590 04/22/2005

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225 FRANKLIN ST  
BOSTON, MA 02110

EXAMINER
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BADIO, BARBARA P

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/072,128

Applicant(s)

LIAO ET AL.

Examiner

Barbara P. Badio, Ph.D.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-46 and 48-62 is/are pending in the application.
- 4a) Of the above claim(s) 3-11, 15, 17-32, 35-42, 46 and 48-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 12-14, 33, 34 and 43-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/04, 8/04, 10/04</u> | 6) <input checked="" type="checkbox"/> Other: <u>IDS 6/03, 5/03</u>                    |

**First Office Action on the Merits**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 16, 2003 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Status of the Claims***

3. Claims 1-15, 17-46 and 48-62 are pending in the present application. Based 3-11, 15, 17-32, 35-42, 46 and 48-62 stand withdrawn as being drawn to a nonelected invention (see Restriction Requirement dated May 30, 2002). Claims 1, 2, 12-14, 33, 34 and 43-45 will be examined to the extent they read on the elected Group, i.e., compounds of formula I wherein R<sub>5</sub> and R<sub>6</sub> together form a double bond between C-5 and C-6 and R<sub>7</sub> is oxo.

Note: Claim 15 is dependent on claim 14 but does not encompass compounds wherein R<sub>7</sub> is oxo.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 2, 12-14, 33, 34 and 43-45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The proviso recited by the instant claims does not find support in the original disclosure because it was not described therein. The examiner notes applicant's references to various pages of the present specification, however, said references do not support the proviso as recited by the instant claims (see MPEP § 706.03(o)). The disclosure of a single compound, i.e., example 3 of the present specification, or a broad genus in the original disclosure does not provide support for the recitation of presently recited proviso. As stated in the MPEP § 706.03(o), new matter also includes the addition of specific compounds after a broader original disclosure. Thus, the present specification does not convey to the skilled artisan in the art that applicant had possession of the presently claimed invention.

***Claim Rejections - 35 USC § 102***

**6. The rejection of claims 1, 2, 12-16, 33, 34 and 43-45 under 35 USC 102(b) over Bleu et al. is withdrawn.**

**7. The rejection of claim 47 under 35 USC 102(b) over Bleu et al. is made moot by the cancellation of the instant claim.**

8. Claims 1, 2, 12-14, 33, 34 and 43-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Park-Chung et al.

Park-Chung et al. sulfated steroids, for example, 7-keto-pregnenolone sulfate, and their effect on NMDA receptors (see the entire article, especially page 1121, Table 1, 2<sup>nd</sup> col., compound #6). The compound and composition taught by the reference are encompassed by the instant claims.

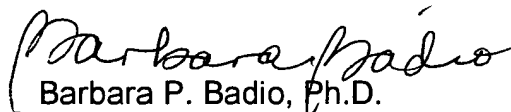
***Telephone Inquiry***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Barbara P. Badio, Ph.D.  
Primary Examiner  
Art Unit 1617

BB

April 15, 2005